

Claims 29-31 and 37-44 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to the skilled artisan that the inventors had possession of the claimed invention at the time the application was filed. The Office Action indicates that applicants may obviate the rejection by providing scientific evidence that the claimed antibodies and immune complexes were actually generated. (Office Action at 3.) Applicants traverse the rejection.

Applicants disagree with the Office's position that a working example is required to show possession of the claimed antibodies and immune complexes. This requirement is inconsistent with current legal precedent. For example, the Court of Appeals for the Federal Circuit has held that the mere fact that something has not previously been done is not a sufficient basis for rejecting all applications purporting to disclose how to do it. *Gould v. Quigg*, 3 U.S.P.Q.2d 1302, 1304 (1987). If a working example is required to show possession of an invention, the holding in *Gould* would be moot. Accordingly, the Office's basis for this rejection is in error, and the rejection should be withdrawn.

Furthermore, the Supreme Court has explicitly stated that "it is well settled that an invention may be patented before it is reduced to practice." *Pfaff v. Wells Electronics Inc.*, 48 U.S.P.Q.2d 1641, 1644 (1998). Clearly, a working example (*i.e.*, reduction to practice) cannot be required to show possession of an invention.

Moreover, in *Pfaff*, the Court indicated that an invention was ready for patenting when the inventor prepared a description of the invention that was sufficiently specific to enable a

person skilled in the art to practice the invention. *Id.* at 1647. The Court found that Pfaff's invention was ready for patenting when Pfaff made drawings that fully disclosed the invention, not when a working example was made. *Id.* The Court's reasoning in *Pfaff* is directly applicable to applicants' invention.

Pfaff's invention was "ready for patenting" without a working example. *Pfaff* at 1647. Consequently, Pfaff must have had possession of the invention without a working example. Likewise, applicants can have possession of their invention without a working example. What applicants need is a description of the invention that is sufficiently specific to enable a person skilled in the art to practice the invention. *See Pfaff* at 1647.

Applicants' specification provides such a description. For example, the specification specifically describes the claimed HIV-1 proteins. (Specification at 13-15.) In addition, the specification specifically describes that the **"proteins may be used . . . as immunogens for the production of antibodies for detection of proteins associated with the retrovirus . . . ."** (Specification at 4, lines 1-10, emphasis added.) Applicants' description is sufficiently specific to enable a person skilled in the art to practice the invention. Consequently, applicants' claimed antibodies and immunocomplexes are ready for patenting. *See Pfaff* at 1647. No working example is required for applicants to patent the claimed antibodies and immunocomplexes. *See id.* at 1644.

Furthermore, applicants submit herewith a Declaration of Dr. Jacques Cohen attesting that the description in the '148 application is sufficiently specific to enable a person skilled in the

art to generate antibodies against HIV-1 p12 and p18 proteins at the time the application was filed.

Applicants respectfully submit that this application is now in condition for allowance. In the event that the Examiner disagrees, he is invited to call the undersigned to discuss any outstanding issues remaining in this application in order to expedite prosecution.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By: 

Salvatore J. Arrigo

Reg. No. 46,063

Tel: 202-408-4000

Fax: 202-408-4400

E-mail: [arrigos@finnegan.com](mailto:arrigos@finnegan.com)

Dated: January 21, 2003

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
[www.finnegan.com](http://www.finnegan.com)